

Attorney Docket No.: 20518/14
USSN: 09/942,334
Art Unit: 2859

REMARKS

A telephonic interview was conducted between Applicants' attorney, Joseph P. Quinn, and Examiner Mirellys Jagan on November 4, 2004. The stated purpose of the telephonic interview was to correct and clarify the record with respect to the Examiner's characterization of Applicants' arguments in the Response to Final Office Action dated August 17, 2004. Applicants gratefully appreciate Examiner Jagan's time and consideration.

Applicants submit that certain language in the Advisory Action dated September 10, 2004 mischaracterizes Applicants' arguments. As discussed in the referenced telephonic interview, Applicants hereby restate these arguments to directly address the language of the Advisor Action and thereby clarify the record.

First, the Advisory Action stated that Applicants' arguments are not persuasive because the rejections are not based on replacing the removable module of McBean (U.S. Patent No. 5,347,476) with the module of Eberly (U.S. Patent No. 3,681,991), rather they are based on modifying the removable module of McBean by adding chambers to the module as taught by Eberly.

Applicants respectfully submit that Applicants' arguments were not directed to rejections that are based on replacing the removable module of McBean with the module of Eberly. The Applicants' arguments first identified relevant components of Eberly and McBean (page 10, paragraphs 1, 2) and argued against any combination of McBean and Eberly (page 10, paragraphs 3, 4).

Second, the Advisory Action stated that Applicants' arguments against McBean and Eberly individually are improper to show non-obviousness of the combination. Applicants respectfully submit that, contrary to the Examiner's apparent characterization, the first two paragraphs of page 10 are not individual arguments aimed at overcoming McBean and Eberly individually. Rather, these paragraphs sequentially itemize elements and deficiencies of Eberly

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and McBean as part of Applicants' overall argument. All of Applicants' statements on page 10 and the first paragraph of page 11 should be considered as a single argument against any combination of McBean and Eberly.

Third, the Advisory Action stated that Applicants' argument that it is not logical to modify Eberly with McBean is not persuasive because the rejections are not based on Eberly in view of McBean, rather the rejections are based on McBean in view of Eberly. Applicants respectfully submit that no part of Applicants' argument is based specifically on modifying Eberly in view of McBean. Rather any combination of McBean and Eberly should be overcome in light of Applicants' arguments.

Fourth, the Examiner indicated Applicants' argument that Examiner's motivation for combining Eberly and McBean, i.e. to avoid cross-contamination is improper, is not persuasive because avoiding cross contamination was not used by the Examiner as motivation for rejecting over McBean in view of Eberly. Applicants' arguments regarding cross contamination addressed discussions in the telephonic interview of 13 May 2004 in which avoidance of cross contamination was a subject of discussion between the Examiner and Applicants' attorney. Applicants argued that no combination of references teaches or suggests each and every element of the rejected claims (page 11, line 16-17). Accordingly, applicant has argued that NO motivation to combine exists without the use of improper hindsight.

The arguments made in Applicants' Response to the Final Office Action are restated below to more specifically address the modification of McBean in view of Eberly.

Rejections under 35 U.S.C. 103(a) over McBean in view of Eberly:

The Examiner maintains that "it would have been obvious at the time the invention was made to modify the removable module disclosed by McBean by adding a chamber in the module for storing the probe and a chamber in the module for storing a supply of disposable probe covers, as taught by Eberly..." (Final Office Action, page 17, lines 12-15).

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The Examiner maintains that the motivation to combine is "in order to store the probe and protect it when it is not being used, and allow a person using the module to have clean probe covers readily available when using the module to take temperature measurements." (Final Office Action, page 17, lines 15 – 17).

Applicants maintain that it is improper to selectively dissect particular components from one reference (i.e. cover storage chambers and probe storage chambers of Eberly) to selectively add them to particular elements of another (a module of McBean) without proper motivation to do so. "It is impermissible within the framework of 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 535 F.2d 238, 147 USPO 391 (CCPA 1965). The Examiner's modification of McBean by selectively dissecting probe storage and cover storage chambers from Eberly to combine with a module of McBean is therefore improper.

Applicants maintain that the stated motivation to combine is insufficient to support the proposed modification without the use of improper hindsight. Applicants respectfully submit that the modules in both McBean and in the present invention as claimed are non-functional when detached from the main unit. Therefore, it is not necessary or helpful to put probe storage in a module if the motivation is to protect it when it is not being used because no more protection is provided by locating probe storage in a module than by locating in a main housing. More importantly, since the module is not functional when detached, it is not necessary or helpful to store probe covers in the module if the motivation is to have clean probe covers readily available when using the module to take temperature measurements. A probe and a cover stored in the main unit (i.e., the measuring meter 36 of McBean) would serve the same functions as those purposes that are already served, for example, by Eberly alone. Accordingly the cited motivation to combine is improper.

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In light of the foregoing remarks, Applicants request the Examiner's reconsideration and withdrawal of the rejections to claims 1-28. Applicants believe that this application is now in condition for allowance and such action at an early date is earnestly requested.

Please charge any fees or credits to deposit account No. 50-0369. Also, in the event any additional extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge deposit account No. 50-0369 therefore.

Respectfully submitted,

Dated: November 5, 2004



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